

REMARKS

Claims 24-48 are pending. Claims 44-48 are new. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 24, 29, 35, 37 and 39 have been amended notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 24, 29, 35, 37, and 39 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Objections

The Examiner objected to the Abstract because it was directed to an apparatus and method and not to a method as claimed therein. The Abstract has been amended. In current form, the Abstract meets the requirements of M.P.E.P. § 608.01(b).

Double Patenting

The Examiner rejected claims 29-33 under 35 U.S.C. § 101 as claiming the same invention as that of claims 4-8 of prior U.S. Patent No. 6,627,000. Claim 29 is independent and has been amended to include features distinct from claims 4-8 of prior U.S. Patent No. 6,627,000. By virtue of their dependence on claim 29, claims 30-33 include features distinct from prior U.S. Patent No. 6,627,000. Therefore, the Double Patenting rejection under 35 U.S.C. § 101 has been overcome.

The Examiner rejected claims 24-28, 35-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-27 of U.S. Patent No. 6,627,000. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

The Examiner rejected claims 24-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,500,267. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

The Examiner rejected claims 24-26, 28-36, 38-40, 42-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-8 of U.S. Patent No. 5,817,276. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

The Examiner rejected claims 24-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,280,686. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

The Examiner rejected claims 24-26, 28-36, 38-40, 42-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,245,293. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

The Examiner rejected claims 24-26, 28-36, 38-40, 42-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, 9-15, and 17-18 of U.S. Patent No. 6,267,924. A terminal disclaimer is enclosed, rendering the double patenting rejection moot.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 24-26, 29-33, 35-36, 39-40, 43 under 35 USC § 102(b) as anticipated by Hollander (USP 5,334,347). This rejection is respectfully traversed.

Hollander is directed to an electric discharge device capable of emitting a large quantity of ultraviolet rays, while also providing a long useful operating life over a wide temperature range (Hollander, 3: 55-57). Hollander's electric discharge device includes a spacer and a base that define a cooling region inside the electric discharge device (Hollander 5:54-56). Hollander's spacer causes a convection current between the cooling region and a radiation region (Hollander 5:57-58, and 6:7-9), resulting in extended life of the germicidal lamp.

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [. . .]
The identical invention must be shown in as complete detail as is contained in the ... claim.

Claims 24, 29, 35 and 39 are independent. Claim 24 has been amended to include the following feature:

positioning the germicidal lamp in proximity to the heat transfer coil, wherein the intensity of the UVC radiation striking the heat transfer coil is, to a degree, independent of the distance of the germicidal lamp to the heat transfer coil.

This feature is disclosed in the Specification in paragraph [0061] on pages 19-20. Claims 29, 35, and 39 have been similarly amended. Therefore the rejection has been overcome.

By virtue of their respective dependence on claims 24, 29, 35 and 39, claims 25-26, 30-33, 36, and 40, 43 are not anticipated by Hollander.

In current form, claims 24-26, 29-33, 35-36, 39-40, and 43 are in form for allowance.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 27-28, 34, 37, 38 and 41-42 under 35 USC § 103 as obvious from Hollander (USP 5,334,347). This rejection is respectfully traversed.

“To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *MPEP 706.02(j)*.

As set forth above in the argument regarding the § 102 rejection of for claims 24, 29, 35, and 39, Hollander does not teach each and every element of claims 24, 29, 35, and 39. Since claims 27-28, 34, 37, 38, and 41-42 are respectively dependent from claims 24, 29, 35, and 39, Hollander does not teach each and every limitation of claims 27-28, 34, 37, 38, and 41-42. Therefore, claims 27-28, 34, 37, 38, and 41-42 are not obvious in view of Hollander. Thus, the rejection should be withdrawn and claims 27-28, 34, 37, 38, and 41-42 should be allowed to issue.

Appl. No. 10/648,101
Amdt. Dated 10/5/2004
Response to Office action dated 7/13/2004

Conclusion

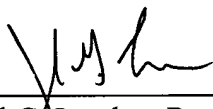
It is submitted, however, that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: October 5, 2004



Joel G. Landau, Reg. No. 54,732

SoCal IP Law Group
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com